

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HOLOGIC, INC., and CYTYC SURGICAL
PRODUCTS, LLC,

Plaintiffs,

v.

MINERVA SURGICAL, INC.,

Defendant.

C.A. No.: 15-1031-JFB-SRF

**PLAINTIFFS' REPLY IN SUPPORT OF MOTION *IN LIMINE* NO. 1
TO EXCLUDE REFERENCE TO OR USE OF *INTER PARTES* REVIEW
PROCEEDINGS RELATING TO THE '183 PATENT-IN-SUIT**

Of Counsel:

Matthew M. Wolf
Marc A. Cohn
ARNOLD & PORTER KAYE SCHOLER LLP
601 Massachusetts Ave., NW
Washington, DC 20001-3743
Telephone: (202) 942-5000
matthew.wolf@arnoldporter.com
marc.cohn@arnoldporter.com

Ryan J. Casamiquela
ARNOLD & PORTER KAYE SCHOLER LLP
Three Embarcadero Center
San Francisco, CA 94111-4024
Telephone: (415) 471-3100
ryan.casamiquela@arnoldporter.com

David A. Caine
Philip W. Marsh
Assad H. Rajani
ARNOLD & PORTER KAYE SCHOLER LLP
Five Palo Alto Square
3000 El Camino Real, Suite 500
Palo Alto, CA 94306
Telephone: (650) 319-4500
david.caine@arnoldporter.com
philip.marsh@arnoldporter.com
assad.rajani@arnoldporter.com

Karen L. Pascale (#2903)
Pilar G. Kraman (#5199)
YOUNG CONAWAY STARGATT & TAYLOR LLP
Rodney Square
1000 North King Street
Wilmington, DE 19801
Telephone: (302) 571-6600
kpascale@ycst.com
pkraman@ycst.com

*Attorneys for Plaintiffs, Hologic, Inc.
and Cytac Surgical Products, LLC*

June 25, 2018

Minerva asserts that the '183 Patent PTO proceedings are relevant to willfulness as to the '183 Patent. In the interest of narrowing the issues for trial, Hologic hereby withdraws its claim for willfulness as to '183 Patent (Hologic will continue to assert willfulness as to the '348 Patent only). With this narrowing of issues, Minerva's argument now fails for this reason alone. The '183 Patent PTO proceedings has no relevance, and would only confuse the jury.

Further, the Court's finding that "Minerva's invalidity defenses are barred by assignor estoppel" also precludes Minerva from relying on the '183 Patent PTO proceedings. (D.I. 407 at 24.) The Court granted Hologic's motion for summary judgment that the '183 Patent is *not* invalid.¹ An unavailable defense cannot provide a reasonable belief of invalidity.

The interim results of the PTO are also not a defense to willful infringement because they occurred after the fact. What matters is Minerva's state of mind *at the time of infringement*. (See D.I. 86 at 8–14 (no assertions of '183 patent invalidity)); *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1340 (Fed. Cir. 2016); *see also Exmark Mfg. Co. Inc. v. Briggs & Stratton Power Prods. Grp., LLC*, 879 F.3d 1332, 1353 (Fed. Cir. 2018).

Any probative value "is substantially outweighed by the risk of unfair prejudice and the risk of confusing the jury." *Personalized User Model, L.L.P. v. Google Inc.*, No. 09-525-LPS, 2014 WL 807736, at *3 (D. Del. Feb. 27, 2014); *Integra LifeSciences Corp. v. HyperBranch Med. Tech., Inc.*, No. 15-819-LPS-CJB, 2018 WL 2186677, at *1 (D. Del. May 11, 2018). There is a high likelihood the jury gives undue weight to the PTO, which applies a different legal standard, and which is on appeal at the Federal Circuit. *XY, LLC v. Trans Ova Genetics, LC*, No. 13-cv-0876-WJM-NYW, 2016 WL 97691, at *2 (D. Colo. Jan. 7, 2016) ("[t]here is a substantial risk that the jury will give undue weight to evidence of a decision by [the PTO].") For these reasons and those in Hologic's Motion (D.I. 392), the Motion should be granted.

¹ Minerva cannot present evidence to the contrary, as Minerva admits that its expert's "opinions on invalidity . . . [are] moot in light of the Court's summary judgment order." (D.I. 423 at 2.)

DATED: July 6, 2018

Of Counsel:

Matthew M. Wolf
Marc A. Cohn
ARNOLD & PORTER KAYE SCHOLER LLP
601 Massachusetts Ave., NW
Washington, DC 20001-3743
Telephone: (202) 942-5000
matthew.wolf@arnoldporter.com
marc.cohn@arnoldporter.com

Ryan Casamiquela
ARNOLD & PORTER KAYE SCHOLER LLP
Three Embarcadero Center
San Francisco, CA 94111-4024
Telephone: (415) 471-3100
ryan.casamiquela@arnoldporter.com

David A. Caine
Philip W. Marsh
Assad H. Rajani
ARNOLD & PORTER KAYE SCHOLER LLP
Five Palo Alto Square
3000 El Camino Real, Suite 500
Palo Alto, CA 94306
Telephone: (650) 319-4500
david.caine@arnoldporter.com
philip.marsh@arnoldporter.com
assad.rajani@arnoldporter.com

YOUNG CONAWAY STARGATT & TAYLOR LLP

/s/ Karen L. Pascale

Karen L. Pascale (#2903)
Pilar G. Kraman (#5199)
Rodney Square
1000 North King Street
Wilmington, DE 19801
Telephone: (302) 571-6600
kpascale@ycst.com
pkraman@ycst.com

*Attorneys for Plaintiffs, Hologic, Inc.
and Cytoc Surgical Products, LLC*

CERTIFICATE OF SERVICE

I, Karen L. Pascale, Esquire, hereby certify that on July 6, 2018, I caused to be electronically filed a true and correct copy of the foregoing document with the Clerk of the Court using CM/ECF (which will send notification that such filing is available for viewing and downloading to all registered counsel), and in addition caused true and correct copies of the foregoing document to be served upon the following counsel of record by electronic mail:

Attorneys for Defendant Minerva Surgical, Inc.:

Benjamin J. Schladweiler
GRRENBERG TRAURIG LLP
The Nemours Building
1007 North Orange Street
Suite 1200
Wilmington, DE 19801

schladweilerb@gtlaw.com

Vera M. Elson
Dale R. Bish
Christopher D. Mays
WILSON SONSINI GOODRICH & ROSATI
650 Page Mill Road
Palo Alto, CA 94304-1050

velson@wsgr.com
dbish@wsgr.com
cmays@wsgr.com

Olivia M. Kim
Neil N. Desai
Edward G. Poplawski
WILSON SONSINI GOODRICH & ROSATI
633 West Fifth Street, Suite 1550
Los Angeles, CA 90071

okim@wsgr.com
ndesai@wsgr.com
epoplawski@wsgr.com

YOUNG CONAWAY STARGATT & TAYLOR, LLP

/s/ Karen L. Pascale

July 6, 2018

Karen L. Pascale (No. 2903) [*kpascale@ycst.com*]

Pilar G. Kraman (#5199) [*pkraman@ycst.com*]

Rodney Square

1000 North King Street

Wilmington, Delaware 19801

Telephone: 302-571-6600

*Attorneys for Plaintiffs, Hologic, Inc.
and Cytoc Surgical Products, LLC*